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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,135	12/01/2003	David Leslie	455444.15034	2639

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Marvin H. Kleinberg  
Kleinberg & Lerner, LLP  
Suite 1080  
2049 Century Park East  
Los Angeles, CA 90067

EXAMINER
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BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/725,135	<b>Applicant(s)</b> LESLIE, DAVID	
	<b>Examiner</b> Jenna-Leigh Befumo	<b>Art Unit</b> 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The Amendment submitted on February 3, 2006, has been entered. Claims 1, 4, 9, and 10 have been amended. Therefore, the pending claims are 1 – 14.
2. The objection to the specification is withdrawn based on the amendment to the claims.
3. The 35 USC 112 1<sup>st</sup> paragraph rejection to claim 4 as lacking enablement is withdrawn due to the amendment to claim clarifying where the attachment means are located.
4. The 35 USC 112 2<sup>nd</sup> paragraph rejection to claims 1 – 14 is withdrawn since the claims have been amended to provide proper antecedent basis to the term “bottom edge”.

### ***Claim Rejections - 35 USC § 112***

5. Claims 3 and 5 – 14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a towel with a slit on a first side edge and attachment means in each of the two corners formed by said first side edge, does not reasonably provide enablement for a towel with a slit on a first side edge and attachment means in each of the two corners formed by the top edge, bottom edge, or side edge. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Claim 3 requires only that the attachment means are located in two of the four corners of the rectangular fabric. Hence, the attachment means can be in any combination of two corners. However, the disclosure only provides support for the attachment means being in the two corners which are on the same edge as the slit. Thus, the claim is broader than the enabled invention because it is claiming where the attachment means are located in corners other than the two corners on the same edge as the slit.

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6. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a plastic coating on the lower portion of the towel where the lower portion is between a side edge of the towel and a line running parallel to the first and second side edges, does not reasonably provide enablement for a towel where the lower portion is between the bottom edge and a line running parallel to the top and bottom edges and not including the slit. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. As set forth in the previous Office Action the claim doesn't limit the upper and lower portions of the towel to a specific orientation. Hence, the lower portion can be defined by a line running parallel to the top and bottom edges or a line running parallel the two side edges. Based on the drawings, the lower portion and upper portion are separated by a line running parallel to the side edges and not the top and bottom edges. Therefore, the claim is claiming a scope broader than the scope of the specification because the specification does not teach defining the lower portion as being between the bottom edge and a line parallel the top and bottom edge, but not including the slit portion. Thus, the claim is not limited to just the invention disclosed by the applicant in the specification.

***Claim Rejections - 35 USC § 102***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1 and 2 stand rejected under 35 U.S.C. 102(b) as being anticipated by Peterson et al. (1,793,243) for the reasons of record.

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9. Claims 1 and 2 stand rejected under 35 U.S.C. 102(b) as being anticipated by Richmond (2,526,505) for the reasons of record.

10. Claims 1, 3, 4, and 8 stand rejected under 35 U.S.C. 102(b) as being anticipated by Farber et al. (3,329,969) for the reasons of record.

11. Claims 1 – 4 and 6 – 7 stand rejected under 35 U.S.C. 102(b) as being anticipated by Rowe et al. (3,332,547) for the reasons of record.

***Claim Rejections - 35 USC § 103***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 3, 5, 8, 9, 11, and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al. in view of Kahn (4,660,225) for the reasons of record.

14. Claim 13 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al. as applied to claim 1 above, and further in view of Rowe et al. for the reasons of record.

Claims 6, 7, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al. and Kahn as applied to claims 3 and 9 above, and further in view of Rowe et al. for the reasons of record.

***Response to Arguments***

15. Applicant's arguments filed February 3, 2006, have been fully considered but they are not persuasive. The applicant argues that Peterson et al. and the other prior art references do not teach the claimed invention because the prior art places the claimed slit in the top edge while the applicant's invention places the slit in the side edge (response, pages 5 – 6). While the applicant is allowed to be his lexicographer, there is nothing in the applicant's disclosure or arguments that

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shows that a side is structurally distinguished from a top or bottom edge except in its location relative to the observer. In the prior art references, the protective covering is rectangular with four sides, one of those sides having a slit which creates an opening. Now the fact that the pictures show the slit on the top of the towel, as opposed to the side of the towel does not distinguish the two inventions since either towel can be turned 90° to move the slit from the side edge to the top edge or vice-versa. For purposes of examination, the side of the cover with the slit in the prior art is considered to be a side edge. Unless the applicant provides some structural definition to the term side edge, as opposed to top or bottom edge, other than the orientation of the edges based on the viewer's perspective, than any of the four edges in the rectangular covers taught by the prior art can be interpreted as a side edge. Thus, the rejections are maintained.

16. Further, the applicant argues that some of the prior art discloses that the slit region is perforated so that a user can rip and tear the slit prior to use to their liking (response, page 6). However, the method the slit is produced does not distinguish the claimed invention from the prior art since the finished product will still have the same structural features as the claimed inventions. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. Thus, both the claimed invention and the prior art inventions will have a cover with four sides wherein one of the sides has a slit or opening extending into the towel at a ninety degree angle to the edge. Thus, the prior art produces the same final product even if perforations are used to create the slit or opening. Therefore, the rejection is maintained.

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17. With regards to the 103 rejections based on Peterson et al., the applicant argues that the prior art fails to teach placing the slit on the side edge as opposed to the top edge. As set forth above there is no structural distinction between the side edge and the top edge. The slit taught in the prior art creates an opening with the same shape and structure as the applicant's claimed opening and which can be placed around a person's neck in the same manner. Thus, the rejections are maintained.

***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

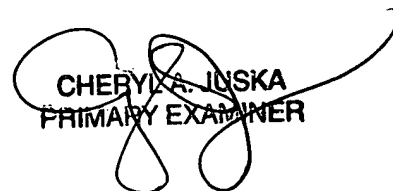
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jenna-Leigh Befumo  
April 10, 2006



CHERYLA J. JASKA  
PRIMARY EXAMINER